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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,058	09/24/2001	John J. Schlager	RICD 00-21	5204

7590

06/19/2003

ATTN: MCMR-JA (Ms. Arwine)  
Office of the Staff Judge Advocate  
U.S. Army Medical Research and Materiel Command  
504 Scott Street  
Ft. Detrick, MD 21702

EXAMINER

ZEMAN, MARY K

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 06/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/961,058

Applicant(s)

SCHLAGER ET AL.

Examiner

Mary K Zeman

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

Claims 1-20 are pending in this application.

#### ***Priority***

Priority under 35 USC 119(e) to a provisional application is acknowledged.

#### ***Compact Disc Submission***

The CD-Rom labeled "COPY 1 REPLACEMENT 4/18/2002" has been entered into the file, and the files therein appear to meet the requirements.

#### ***Drawings***

The drawings filed with the application are acceptable to the examiner.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of claim 1 (and therefore all claims dependent thereon) are unclear. The preamble states that the goal of the method is to identify a nucleic acid, however the steps of the recited method do not lead to the identification of any nucleic acid. At best, one arrives at a second spreadsheet which comprises certain selected pieces of information about related sequences. Further, what aspect is to be identified? Similarity to known sequence? Identity to known sequence? Genes located within a sequence? Coding regions? Non-coding regions? The claim is not illuminating in this regard.

In claim 6, it is unclear where in the steps of claim 5, and ultimately claim 1 where the additional directories should be created, and when within the method.

In claim 7, it would appear that all steps after step (d) would have to also be performed at a preset later time, or else they cannot be done. The claim as written does not require that.

In claim 12, it is unclear how the step can be "based upon" a subjective value such that the step can be performed.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Burland (2000).

The claims are drawn to methods of identifying nucleic acids by creating certain database files, submitting a raw sequence, automatically trimming the sequence, searching the trimmed sequence against an identification database, receiving information about the search, selecting information from those results and inputting them into spreadsheets. The database can be the publicly available NCBI database.

Burland (Burland, T. Methods in Molecular Biology (2000) Vol. 132: Bioinformatic methods and protocols, pages 71-91.) discusses the commercial computer product Lasergene, version 4.0, available from DNASTar in 1999, and a method of using the product. This program allows for the inputting of a raw sequence, which can be done electronically. The sequence can then be automatically trimmed, based on various user inputs, or the use of default settings. This information is saved in files of various formats. The sequence can be further edited. The sequence is searched against databases (such as the database of NCBI) containing nucleic acid sequences using BLAST. The limitations of claim 11 are standard results from a BLAST query. The results are returned to the user in a format which can be a spreadsheet, or combine graphical information with the spreadsheet. Information from the first set of results can be selected and placed in a second spreadsheet. Various search strategies and implementations are discussed.

As such, this commercial product, and the disclosed method of using that product anticipate the claims.

***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (703) 305-7133.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached at (703) 308-4028.

Official fax numbers for this Art Unit are: (703) 308-4242, (703) 872-9306. An *unofficial* fax number, direct to the Examiner is (703) 746 5279. Please call prior to use of this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC1600 Receptionist whose telephone number is (703) 308-0196.

mkz  
6/4/03

M. K. ZEMAN  
EXAMINER



MARY K. ZEMAN  
PRIMARY EXAMINER

